REMARKS

Claims 1-26 are pending in the application. In the Office Action, the Examiner rejects Claims 1-20. Applicants respectfully traverse, and request reconsideration and allowance of all pending claims.

Claim Rejections – 35 U.S.C. § 112

The Examiner rejects Claims 1-20 under 35 U.S.C. § 112, first paragraph, as failing to comply with the enablement requirement. The Examiner proposes two reasons for this rejection. First, the Examiner states:

> Storing a portion of a printed financial prospectus to a bar code critical to the practice of the invention, but not included in the claim(s) is not enabled by the disclosure. The examiner is unaware of any analog/digital converter scheme that allows for the storing of information contained within a financial prospectus.

(Office Action; page 2). Thus, the Examiner asserts that the disclosure does not enable an "optical bar code" that stores a "portion of the prospectus data," as recited in Claim 8. In making this rejection, however, the Examiner misinterprets the enablement standard. "The test of enablement is whether one reasonably skilled in the art could make or use the invention from the disclosures in the patent coupled with information known in the art without undue experimentation." *United States v. Telectronics, Inc.*, 857 F.2d 778, 785, 8 USPQ2d 1217, 1223 (Fed. Cir. 1988). If the Examiner expects a primer on how a bar code stores information, then the rejection is not properly based on the enablement standard. To satisfy the enablement standard, Applicant's Specification is not required to teach every detail regarding how data may be stored in a bar code. In the Office Action, the Examiner does not dispute that a bar code may store information. Furthermore, the Examiner fails to point out why any "undue experimentation" would be required if the information to be stored is a "portion" of "prospectus data" as recited in Claim 8. Because storing a "portion" of "prospectus data" in a bar code would not require any "undue experimentation" by one of ordinary skill in the art, Applicant's Specification satisfies the enablement standard.

In the Office Action, the Examiner proposes a second reason for the rejection under 35 U.S.C. § 112, first paragraph. In particular, the Examiner states: "The specification fails

to teach how to encrypt a bar code." (Office Action; page 2). At the outset, this particular rejection cannot apply to all of Claims 1-20, as the Office Action suggests. Only dependent Claims 6 and 12 relate to the term "encrypt." In addition, the Examiner mischaracterizes Claims 6 and 12. Neither of these claims recites "encrypting a bar code." Instead, Claim 6 recites "encrypting the first portion of prospectus data" and Claim 12 recites that "the first portion of the prospectus data is encrypted." Thus, Claims 6 and 12 relate to encrypting *data* -- not a bar code. This aspect of Claims 6 and 12 is adequately supported by Applicant's Specification on at least page 5, line 21 to page 6, line 4.[1] Accordingly, one of ordinary skill in the art would be enabled to encrypt a portion of prospectus data without undue experimentation. For at least the foregoing reasons, Applicants respectfully request reconsideration and allowance of Claims 1-20.

Claim Rejections – 35 U.S.C. § 102

The Examiner rejects Claim 1 under 35 U.S.C. § 102(b) as being anticipated by U.S. Patent No. 6,750,777 issued to Larson et al. ("*Larson*"). Applicants traverse the rejection and respectfully requests reconsideration and allowance of Claim 1.

The rejection of Claim 1 is improper for several reasons. First, the Office Action fails to identify the particular parts of *Larson* that are relied upon to reject Claim 1. Second, *Larson* fails to teach, suggest, or disclose "determining a first portion of prospectus data, wherein a printed financial prospectus comprises the first portion of prospectus data in a human-readable format" as recited, in part, in Claim 1. Third, *Larson* fails to teach, suggest, or disclose "encoding the first portion of prospectus data as a first optical bar code" as recited, in part, in Claim 1.

First, the Office Action fails to identify the particular parts of *Larson* that are relied upon to reject Claim 1. "When a reference is complex or shows or describes inventions other than that claimed by the applicant, the particular part relied on must be designated as nearly as practicable." 37 C.F.R. § 1.104(c)(2). In rejecting Claim 1, the Office Action only states: "Claim 1 is rejected under 35 U.S.C. 102(b) as being anticipated by U.S. Patent 6,750,777." (Office Action; page 2). The Office Action does provide any further discussion of how

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[1] This portion of Applicant's specification is cited merely to illustrate at least one embodiment of "encrypting the first portion of prospectus data," as recited in Claim 6. The cited portion of Applicant's specification is not intended to limit the claims to any particular embodiment.

Larson supports this conclusion. Indeed, the Office Action completely fails to identify any paragraph or figure in Larson to support the conclusory rejection of Claim 1. By failing to designate any part of *Larson*, the Office Action fails to comply with the requirements of 37 C.F.R. § 1.104(c)(2). Accordingly, the rejection of Claim 1 is improper.

Second, *Larson* fails to teach, suggest, or disclose "determining a first portion of prospectus data, wherein a printed financial prospectus comprises the first portion of prospectus data in a human-readable format" as recited, in part, in Claim 1. It is well established that a "claim is anticipated only if *each and every element* as set forth in the claim is found, either expressly or inherently described, in a single prior art reference." *Verdegaal Bros. v. Union Oil Co. of California*, 814 F.2d 628, 631, 2 USPQ2d 1051, 1053 (Fed. Cir. 1987) (emphasis added). *Larson* describes a library terminal that may comprise a bar code scanner. (Column 4, line 57 – column 5, line 10). *Larson* explains that the bar code scanner may be used to scan a bar code on a library card or a circulating item, such as a book. (Column 5, lines 1-4). *Larson* explains that a bar code on a library card may identify a patron. (Column 11, lines 48-51). *Larson* further explains that an item identifier on a circulating item may identify the circulating item. (Column 5, lines 55-58). There is nothing in *Larson* that teaches, suggests, or discloses "prospectus data" or "determining a first portion of prospectus data" as recited in Claim 1. *Larson* further fails to teach, suggest, or disclose "a printed financial prospectus" that "comprises the first portion of prospectus data in a human-readable format" as recited in Claim 1. Because *Larson* fails to teach, suggest, or disclose these aspects of Claim 1, *Larson* fails to support the rejection.

Third, *Larson* fails to teach, suggest, or disclose "encoding the first portion of prospectus data as a first optical bar code" as recited, in part, in Claim 1. As explained above, *Larson* fails to teach, suggest, or disclose "prospectus data" as recited in Claim 1. *Larson* further fails to teach, suggest, or disclose "encoding the first portion of prospectus data as a first optical bar code" as recited, in part, in Claim 1. Because *Larson* fails to teach, suggest, or disclose this aspect of Claim 1, *Larson* fails to support the rejection. For at least these reasons, Applicants respectfully request reconsideration and allowance of Claim 1.

Claim Rejections – 35 U.S.C. § 103

The Examiner rejects Claims 1-20 under 35 U.S.C. § 103(a) as being unpatentable over *Larson*. Applicants traverse the rejection and respectfully requests reconsideration and allowance of Claims 1-20.

Claims 1, 8, 14

The rejection of Claim 1 under 35 U.S.C. § 103(a) is improper for several reasons. First, the Office Action again fails to identify the particular parts of *Larson* that are relied upon to reject Claim 1. Second, Applicants traverse the Examiner's reliance on Official Notice. Third, even if the Official Notice were permissible (which Applicants traverse), the combination of *Larson* and the Official Notice fails to teach, suggest, or disclose each element of Claim 1.

First, in making the obviousness rejection, the Office Action again fails to identify the particular parts of *Larson* that are relied upon to reject Claim 1. Without citing any portion of *Larson*, the Office Action makes the following conclusory statement: "The patent teaches that it is well know to affix a bar code to a library holding." (Office Action; page 3). Clearly, this conclusory statement fails to address each element of Claim 1. Because the Office Action fails to identify any particular part of *Larson* that supports the rejection of Claim 1, the Office Action fails to comply with the requirements of 37 C.F.R. § 1.104(c)(2). Accordingly, the rejection of Claim 1 is improper.

Second, the Examiner's reliance on Official Notice is improper. In rejecting Claims 1-20, the Office Action states: "The examiner takes official notice that a libraries [sic] holdings can include a financial prospectus." (Office Action; page 3). There is nothing in any of the cited references that supports this assertion. Accordingly, Applicants traverse this assertion and respectfully submits that "the examiner *must* provide documentary evidence in the next Office Action if the rejection is to be maintained." MPEP § 2144.03(C) (emphasis added). Because the Examiner's reliance on Official Notice is unsupported, the rejection is improper. Applicants demand that the Examiner provide substantive evidence of the facts so noticed in the rejection is to be maintained.

Third, even if the Official Notice were permissible (which Applicants traverse), the combination of *Larson* and the Official Notice fails to teach, suggest, or disclose each element of Claim 1. As explained above, *Larson* fails to teach, suggest, or disclose

"determining a first portion of prospectus data" and "encoding the first portion of prospectus data as a first optical bar code" as recited, in part, in Claim 1. Merely taking Official Notice that a library's holdings can include a financial prospectus does not cure the deficiencies of *Larson*. In particular, even if *Larson* taught that a library's holdings included a financial prospectus, there is nothing in *Larson* that teaches "a first portion of prospectus data" or "*determining* a first portion of prospectus data" as recited Claim 1. (Emphasis added). Furthermore, there is nothing in *Larson* that teaches, suggests, or discloses "*encoding* the first portion of prospectus data as a first optical bar code" as recited in Claim 1. (Emphasis added). Because the combination of *Larson* and the improper Official Notice fails to teach, suggest, or disclose these aspects of Claim 1, the rejection is improper. For at least the foregoing reasons, Applicants respectfully request reconsideration and allowance of Claim 1.

The Office Action fails to specifically address Claims 8 and 14. Applicants note that Claims 8 and 14 are allowable for reasons that are analogous to those stated above with respect to Claim 1. Accordingly, Applicants respectfully request reconsideration and allowance of Claims 8 and 14.

Claims 2-7, 9-13, 15, 19, and 20

Claims 2-7, 9-13, 15, 19, and 20 depend from independent claims shown above to be allowable. In addition, these claims recite further elements not taught, suggested, or disclosed by *Larson*. Applicants reserve the right to argue these additional elements at a later time.

Applicants notes that the Office Action fails to address most of the dependent Claims. For example, the Office Action does not address at least dependent Claims 3-7, 9-10, 12-13, and 19-20. Applicants request that the Examiner consider and allow Claims 2-7, 9-13, 15, 19, and 20.

Claims 21-26

In his Response to the previous Office Action, Applicants added Claims 21-26. It appears to Applicants that the Examiner has ignored these claims. In particular, the Office Action does not include any discussion or any indication of allowance or rejection of Claims 21-26. Accordingly, Applicants request that the Examiner consider and allow Claims 21-26.

CONCLUSION

Applicants submit that the Examiner has failed to establish a prima facie case in rejecting the claims in the present application as indicated above. Reconsideration of Claim 1 is respectfully requested. For those claims that have not been considered and/or properly rejected, i.e., all claims other than Claim 1, consideration and allowance is respectfully requested.

The Examiner is invited to contact the Applicant's undersigned representative at 212-829-5407 to expedite prosecution

Respectfully submitted,

March 27, 2007   /Antonio Papageorgiou/

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